

Appl. No. 09/929,398
Amdt. dated November 21, 2005
Reply to Office Action of August 26, 2005

PATENT

Amendments to the Drawings:

The attached sheets of drawings include changes to Fig. 4, 5D, 5E and 6. These sheets, which include Fig. 4, 5D, 5E and 6 replaces the original sheets including Fig. 4, 5D, 5E and 6.

Attachment: Replacement Sheets
Annotated Sheets Showing Changes

REMARKS/ARGUMENTS

Objections to Drawings of Specification

Regarding objections in paragraph 1a and 1e-1k, Figures 4, 5A-5E, and 6 the corresponding amendments have been made as the Examiner suggested. A redlined set of Figures is submitted along with formalized versions for entry upon approval.

Regarding objections in paragraph 1b, 1c and 1d, Applicants respectfully note that the claimed invention is neither a large machine nor device as set forth in 37 CFR .184 (h)(2). Figures 4, 5A-5E, and 6 are merely flow charts that are commonly used for illustrating the methods of the invention by those of ordinary skill in the art. Unlike machines or devices, flow charts have no spatial dimension to them such that partial machine-views make no sense. Therefore, it is believed that the flow charts are not within the categories stated in 37 CFR .184 (h)(2) so that no small scale view is necessary. Following the same logic, the objection in 1d is respectfully believed inappropriate because these are not partial views of a machine or device. Those of ordinary skill in the art certainly understand this common way to do flow charts.

Amendments

The specification and figures are amended to correct the page numbering and several oversights that are grammatical, clerical or typographical in nature. The changes to the specification outlined in paragraph 2 of the Office Action by the Examiner are fixed accordingly.

Additionally, the claims are modified in the amendment. More specifically, claim 1, 14, 15, 17, and 20-23 have been amended. Therefore, claims 1-27 are present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §101 Rejection

Claims 17, 22 and 27 are rejected under 35 U.S.C. §101 because the claimed invention is directed to statutory subject matter. Claim 17 and 22 have been amended to address

some of the Examiner's concerns. The issue of the scope of "technological arts" is addressed below.

Based on the recent decision in *Ex Parte Lundgren* from the Board of Patent Appeals and Interference, there is no separate "technological arts" test for determining whether a claimed process amounts to statutory subject matter under 35 U.S.C. 101. Therefore, the rejection of Claim 22 and 27 due to the lack of technological arts is respectfully traversed. Furthermore, irrespective to the recent decision in *Lundgren*, Applicants respectfully note that the claim terms such as "device," "machine," and "wireless" are all within the scope of the technological arts. Reconsideration is respectfully requested.

35 U.S.C. §112 Rejection

Claims 1-13, 15-16 and 20-27 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 15, 20 and 21 have been amended to address the Examiner's concerns.

With regard to Claim 1 and 22, Applicants respectfully believe that no structure is needed in the method claims associated with the step to enable the step to be performed. If this rejection is maintained, Applicants respectfully request further explanation as to why structure is needed in the method claims.

35 U.S.C. §103 Rejection, Caruso

The Office Action has rejected claims 1-13 and 22-27 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of article, "Children's hospital shines light on net problems" to Caruso (hereinafter "Caruso"). Applicants believe there are limitations in claims 1 and 22 that are neither taught nor suggested by Caruso. More specifically, the automatically determining a threshold event that is programmed limitation is missing from the Caruso reference. Further, the motivation to mix and match portions of Caruso in the suggested combination is not properly set forth in the Office Action. For all these reasons, reconsideration is respectfully requested.

Missing Limitations

The rejection is respectfully traversed in light of the amendment of claim 1 and 22. In one of the embodiments of the present invention, the data capture device (116) logs events reported from the business machine (112) and includes threshold events that trigger communication back to the operation center (104) which determines the threshold events (Application, page 3, line 31 to page 4, line 2). It is noted that the threshold events are "automatically" determined by the operation center associated with the service contract in the present invention. On the contrary, in Caruso, there is no suggestion or indication that the threshold events, namely the power utilization or battery level, are determined automatically. It is reasonably believed that the threshold events in Caruso, such as the power utilization or battery level, are most likely either pre-determined or determined manually, but the reference seems silent on this point.

Motive to Combine

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. It is noted that a *prima facie* case of obviousness has not been properly set forth in this Office Action. Indeed, no cite is made to any reference for a motivation to combine. Therefore, Applicants believe that motivation for the specific combination of elements in Caruso is lacking.

35 U.S.C. §103 Rejection, Fraker

The Office Action has rejected claims 14-21 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 5,919,239 to Fraker (hereinafter "Fraker"). Fraker does not, either alone or in combination, teach or suggest the invention in light of the amendment in claim 14. More specifically, Fraker does not teach any use of a web interface remote to the operations center nor the web interface allows users to remotely interact

with service contract information. Further, apparent Official Notice is relied upon for some of the limitations. Reconsideration is respectfully requested.

Missing Limitations

Claim 14 has been amended to recite that the web interface is remote to the operations center, and the web interface allows users to remotely interact with service contract information. In Fraker, the computer system, is not remote but in the command center **90** (Col. 6, line 2-3). Moreover, Fraker discloses the vehicle/engine control computer **102** of a motor vehicle **106** preferably monitors various vehicle and engine operation parameters and continuously broadcasts such information over the data communication link **104** to the command center (Col. 6, line 21-24). Namely, the user does not even participate in any interaction between the control computer and command center in Fraker. Therefore, there is no indication or suggestion that the user in Fraker is allowed to remotely interact with service contract information. Accordingly, Applicants believe that Fraker does not teach any limitation in light of the amended Claim 14.

Furthermore, while Fraker discloses a monitor system of the business machine (e.g., vehicle engine temperature) and determines its relationship to a threshold (Office Action, Page 14, Line 15-17), it does not disclose the "communication" between the two platforms. When the engine temperature rises to with a range of normal operating temperatures, processor **20** is responsive thereto to generate a programming signal(s) corresponding to a desired operational program (Col. 9, line 59-63). It is noted that the monitoring system in Fraker just passively notifies when there is the threshold event. No suggestion or indication that the monitoring system "communicates" the threshold with the vehicle. However, in the claimed invention, the operation center not only determines a threshold related to a service contract but "communicates" that threshold to one of the plurality of data capture devices (e.g. Application, page 10, line 4-13, Fig. 5A). Therefore, Applicants believe that Fraker does not teach this limitation.

Express showing of Proof for Official Notice

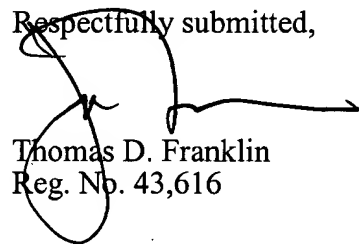
It is noted that the Office relies the Official Notice that vehicles are serviced whether routinely or preventively and that service for fleet vehicles is commonly performed by processing or interacting with a service contract in order to ensure that the vehicles are maintained to avoid unexpected unavailability. Office Action, page 14, paragraph 6. An express showing of documentary proof is respectfully requested for this proposition as is set forth in MPEP 2144.03. This documentary proof would allow the Applicants the opportunity to demonstrate how a particular prior art teaching would not work in the claimed application.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


Thomas D. Franklin
Reg. No. 43,616

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
Attachments
TDF:cmb
60634227 v1

(ANNOTATED SHEET SHOWING CHANGES)

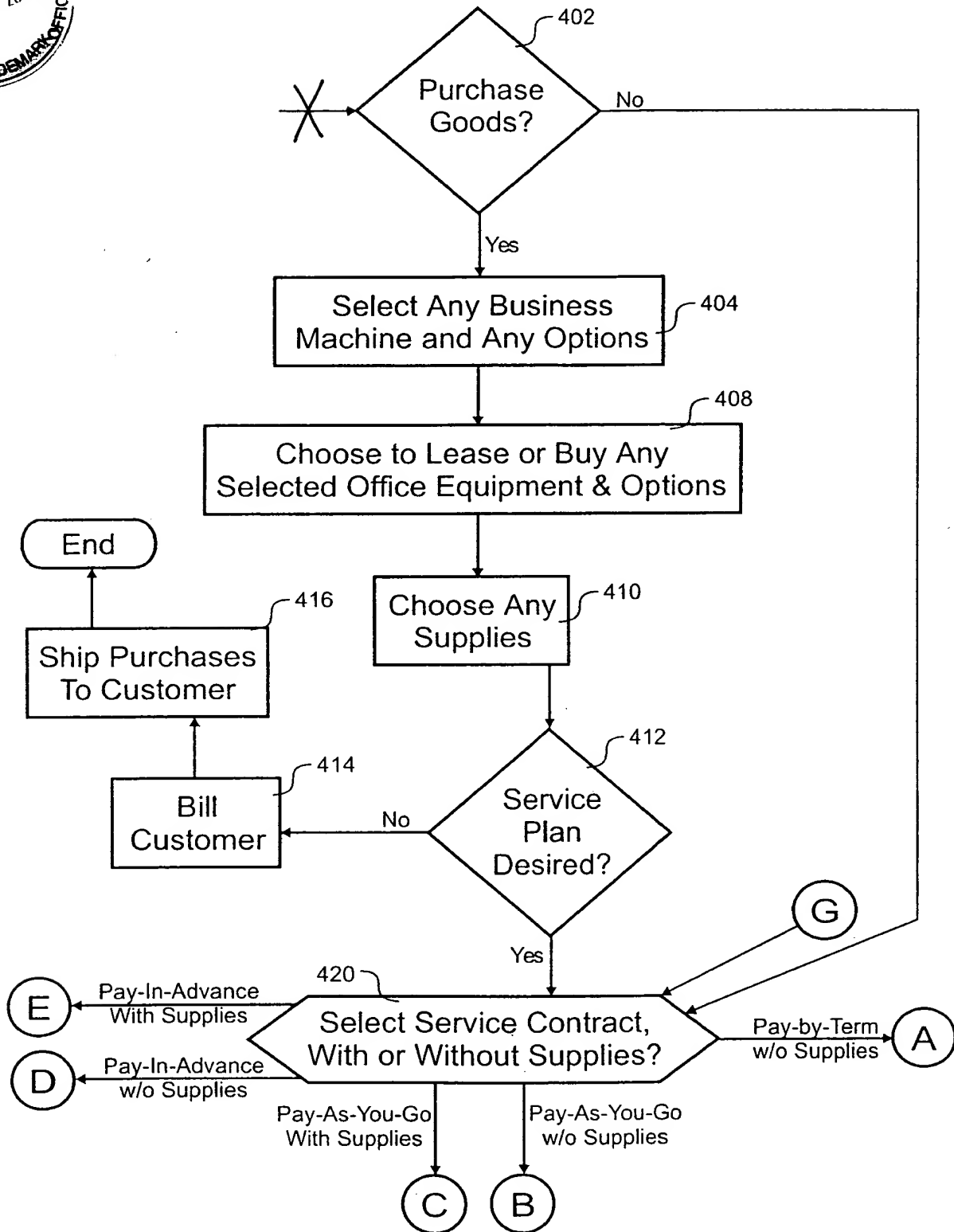


Fig. 4

(ANNOTATED SHEET SHOWING CHANGES)

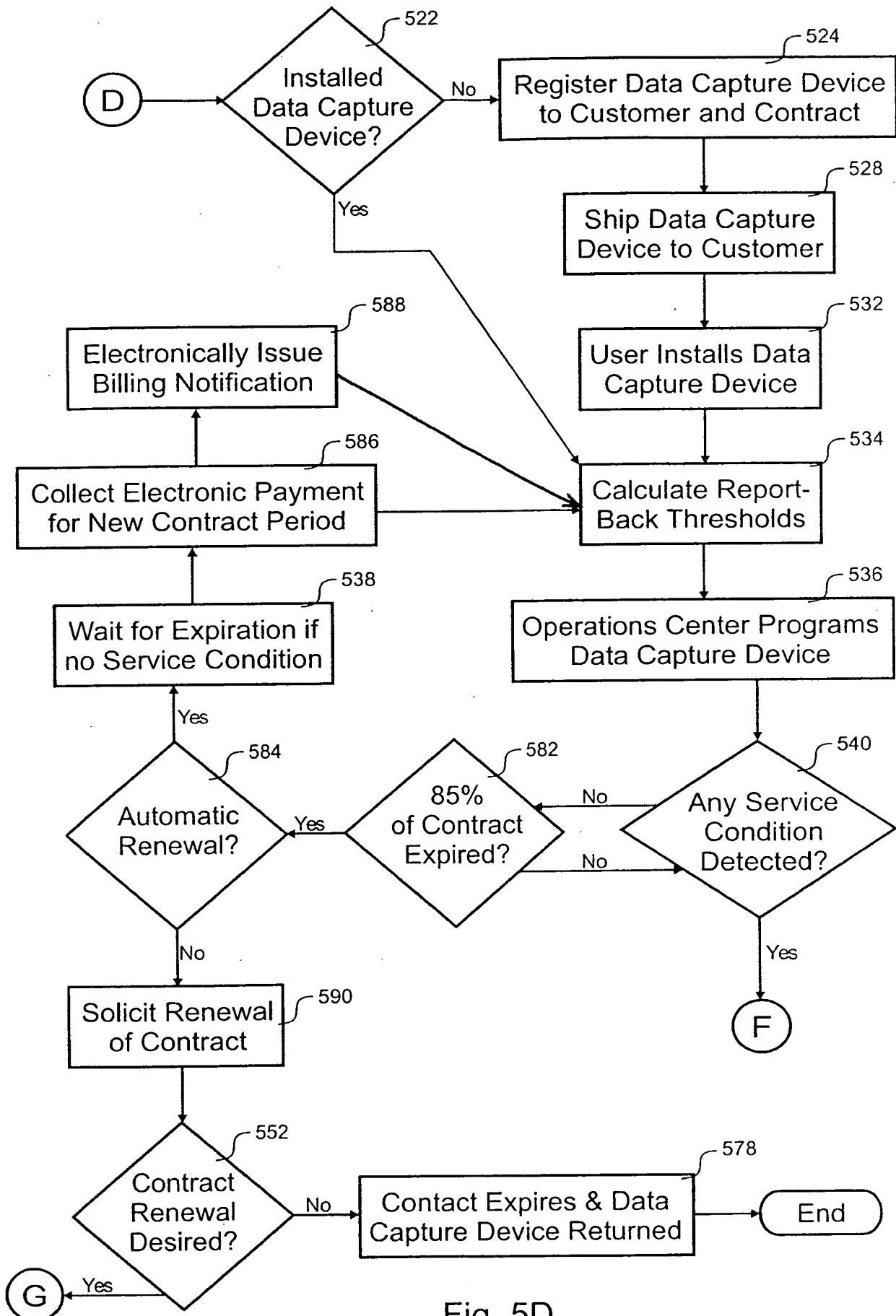


Fig. 5D

(ANNOTATED SHEET SHOWING CHANGES)

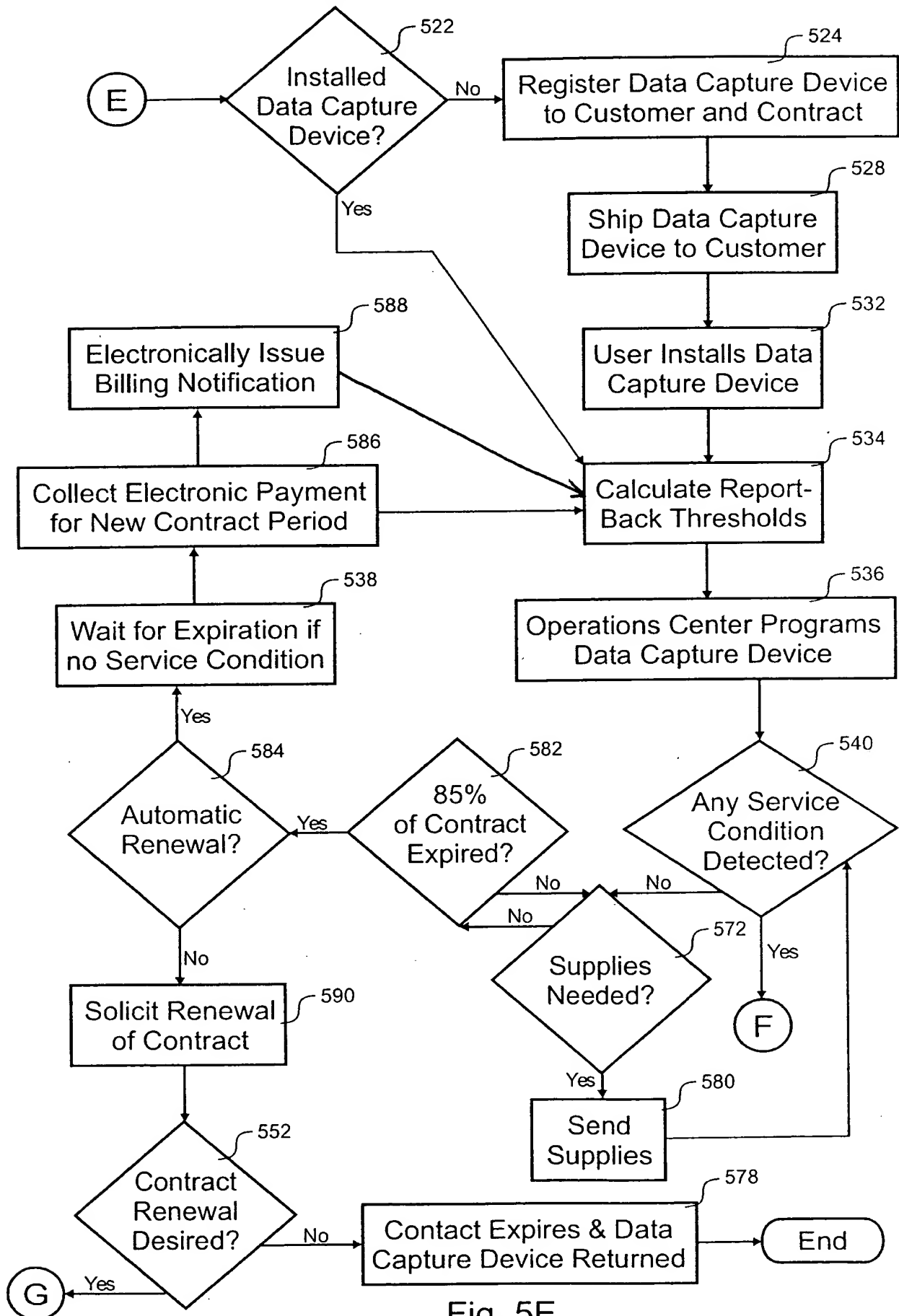


Fig. 5E

(ANNOTATED SHEET SHOWING CHANGES)

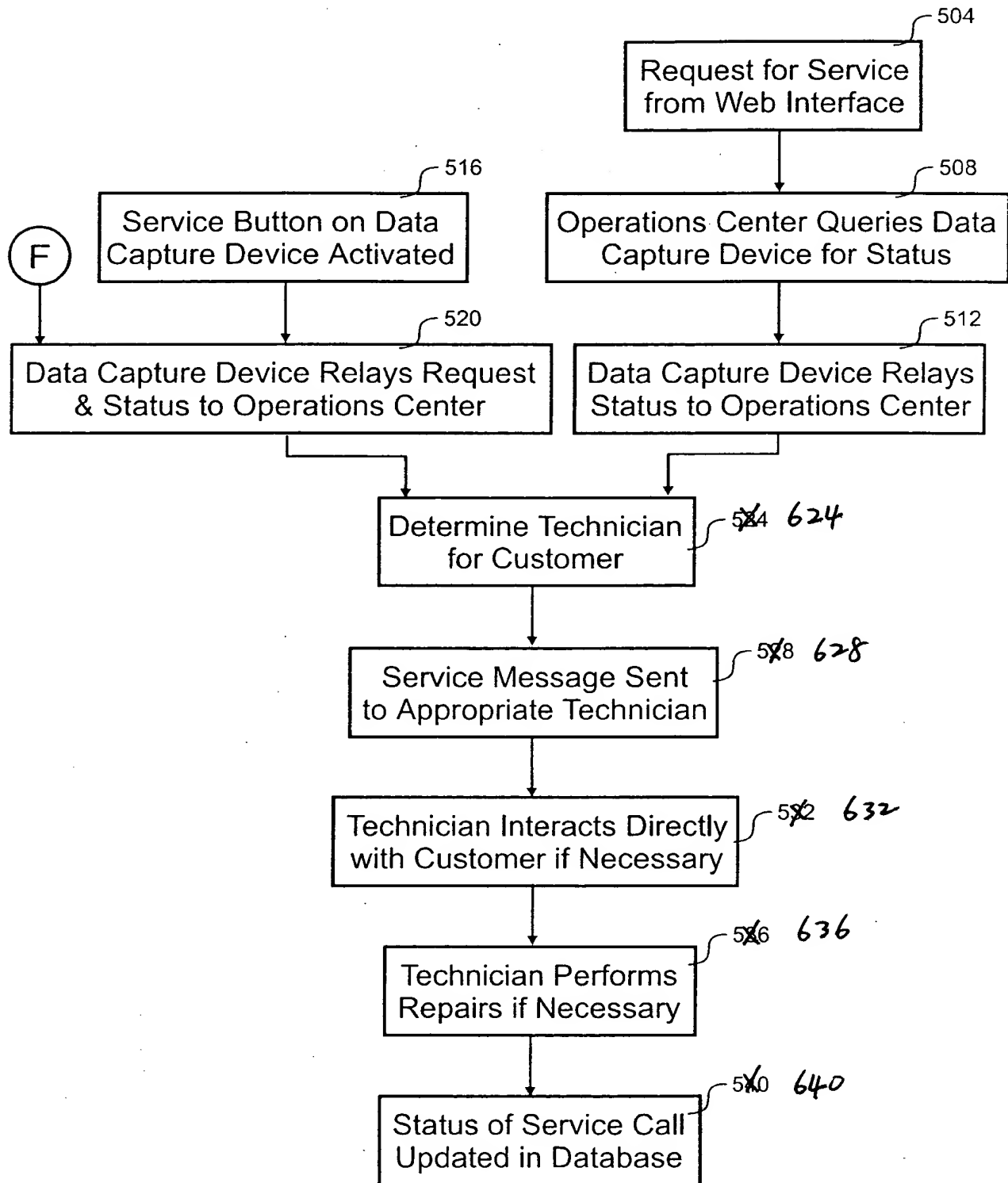


Fig. 6